



3727

PATENT  
P56559PCT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Louis Lagler, et al.

Serial No.: 09/890,154

Examiner: Robin Annette Hylton

Filed: 23 October 2001

Art Unit: 3727

For: *CLOSED INJECTION MOLTED CLOSURE*

**PETITION UNDER 37 CFR §1.181**

**Mail Stop Petition**

Commissioner For Patents

P.O. Box 1450

Alexandria, VA., 22313-1450

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Sir:

In response to an Office Action (Paper No. 15), mailed 13 April 2004, entry and consideration of the following timely filed petition is respectfully requested.

Folio: P56559PCT

Date: 27 April 2004

I.D.: REB/Rsh

**STATEMENT OF FACTS**

1. On the 13<sup>th</sup> of April 2004 the Examiner mailed an Office Action (Paper No. 15). Paper No. 15 mentioned the requirement of labeling Figure (1) "Prior Art."

2. Three copies of Decisions on Petition for the following references previously issued by Group Directors are enclosed:

- Paper No. 21 issued on 25 February 1998 for U.S. Application S.N. 08/447,279 filed on 22 May 1995;
- Paper No. 15 issued on 2 October 1996 for U.S. Application S.N. 08/343,939 filed on 17 November 1994; and
- Paper No. (unknown) issued on 15 December 1999 for U.S. Application S.N. 08/985,544 filed on 5 December 1997.

**ARGUMENTS AND/OR REMARKS**

In Paper No. 15, the Examiner objected to Fig. (1) as not being labeled as "Prior Art" stating that "only that which is old is illustrated", and referring to MPEP §608.02(g), which states:

Figures showing the prior art are usually unnecessary and should be cancelled, Ex parte Elliott, 1904 C.D. 103; 109 O.G. 1337. However, where needed to understand applicant's invention, they may be retained if designated by a legend such as "Prior Art."

If the prior art figure is not labeled, the following paragraph may be used.

Figure (1) should be designated by a legend such as Prior Art in order to clarify what is applicant's invention. (See MPEP w 608.02(g)).

Applicant has explained that Fig. (1) is not "Prior Art".

First, nothing in any paragraph of 35 U.S.C. §102 suggests that subject matter which is "old" constitutes prior art.

Second, §608.02(g) merely suggests that labels accompanying some of the drawings are not inappropriate. Additionally, §608.02(g) uses the phrase "such as "Prior Art"". Accordingly, §608.02(g) does not require a figure to be labeled as "Prior Art", but merely suggests that the figure be labeled in some manner in view of the phrase "should be designated by a legend such as Prior Art in order to clarify what is applicant's invention". Thus, §608.02(g) does not state that the figure must be labeled. Further, the Applicant's invention is defined by the claims, and pending elected claims are drawn towards apparatus which can not be confused by the illustration of Fig. (1). In other words, Fig. (1) does not need to be labeled in order to clarify what is Applicant's invention as set forth by the pending claims.

Third, Fig. (1) is not believed to constitute "Prior Art" as that term is defined by either 35 USC §102 or 35 USC §103. As evidenced from the Declaration/Oath, the Applicant is a citizen of Switzerland and, as such, devised Fig. (1) in Switzerland in order to illustrate Applicant's discovery of problems plagued in the art. Therefore, since there is no showing that Fig. (1) was known to anyone other than the Applicant *in this country* nor is there a showing that Fig. (1) was *patented or published in this country or a foreign country*, then Fig. (1) can not be deemed to be "Prior Art" absent evidence to the contrary.

Fourth, Fig. (1) is simply an abstract representation of the art prepared by the Applicant in an effort to illustrate Applicant's discovery of problems plagued in the art in accordance with 37 CFR §1.83(b); this discovery is itself, together with Appellant's abstraction of the art represented by Fig. (1), part of the Applicant's invention. By identifying deficiencies in the prior art and then addressing those deficiencies, Applicant completes the inventive process. As such, Applicant's effort to identify deficiencies or other undesirable features in the art, does not constitute "Prior Art" as that term is used under 35 USC §103, and defined by 35 USC §§102(a)-(g).

Fifth, Applicant has never made any statement admitting that Fig. (1) is "Prior Art". The present application is based on PCT Application Serial No. PCT/CH99/00510 on which the Applicant has claimed priority as evidenced by the Declaration (Oath). MPEP §706.02(c) states, in part:

"The language "in this country" means in the United States only and does not include other WTO or NAFTA member countries."

There is no evidence that Fig. (1) exists in any printed form other than in the present application and its priority document. There is evidence to indicate that Applicant devised the subject matter in Fig. (1) however, and that evidence lies in the fact that the only existence of Fig. (1) is in the present application and its priority document.

**REMEDY REQUESTED**

The Commissioner is respectfully requested to:

- A. Withdraw the requirement to label Fig.(1) as "Prior Art";
- B. Return the prosecution history to the Examiner to reprove any assertion that Fig. (1) should be identified as "Prior Art"; and
- C. Grant Applicant such other and further relief as justice may require.

Respectfully submitted,



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Folio: P56559PCT  
Date: 27 April 2004  
I.D.: REB/RSh

DEC 15 1999

As of the Director  
Group 3600



UNITED STATES OF AMERICA  
Patent and Trademark Office  
ASSISTANT SECRETARY AND COMMISSIONER  
OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231



ROBERT E BUSHNELL  
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1522 K STREET, N.W., SUITE 300  
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17 1999

NA

In re application of  
Hae-Won Ahn  
Serial No.: 08/985,544  
Filed : December 5, 1997  
For: FRONT CASE STRUCTURE OF CRT  
DISPLAY DEVICE

P54947

: DECISION ON PETITION  
: UNDER 37 CFR §1.181  
: REQUESTING THAT  
: THE COMMISSIONER  
: INVOKE SUPERVISORY  
: AUTHORITY

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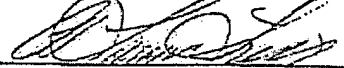
In the renewed petition filed September 9, 1999, applicant requested that the Commissioner invoke supervisory authority by instructing the examiner to withdraw the requirement that Figs. 1 and 2 be labeled as "Prior Art". The petition is GRANTED.

This petition presents two issues. First, are the figures in question necessary to the understanding of the invention? A review of the application has been made and it is considered that the figures are necessary to the understanding of the invention. Second are the figures required to be labeled with the legend "Prior Art"?

A careful review of the application papers indicates that the subject matter of Figures 1 and 2 are considered by applicant to be "conventional". However, there is no indication in the disclosure that the subject matter of the figures is expressly considered by the applicant to be "Prior Art". If applicant states that something is prior art, it is available for use against the claims. See In re Nomiya, 184 USPQ 607 (CCPA 1975), MPEP §2129. No opinion is expressed in this decision whether the subject matter of Figures 1 and 2 are "Prior Art" since this is an appealable issue, MPEP §1201.

Finally, any concerns raised in the previous decision regarding applicant's duty of disclosure are withdrawn. The Office does not normally investigate such issues. 1135 Off. Gaz. Pat. Office, 13 (Jan. 9, 1992).

This application is being forwarded to the examiner for reinstatement of Figs. 1 and 2 and deletion of the amendment after final filed August 4, 1999.

  
Al Lawrence Smith, Director  
Technology Center 3600  
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AK

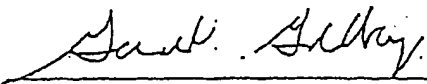
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should be designated with the legend of "prior art". No requirement is made for an applicant to label figure(s) as "prior art" where there is no such indication in the disclosure.

Consequently, the requirement that figures one through three each be designated by the legend of "prior art" is withdrawn.

As the time for perfecting the appeal under 37 C.F.R. § 1.192(a) has expired without the submission of an Appeal Brief, the appeal is hereby dismissed, 37 C.F.R. § 1.192(b). The application file will be forwarded to the examiner for appropriate action in due course.

SUMMARY: Petition GRANTED

A handwritten signature in cursive script, appearing to read "Gerald Goldberg", is written over a horizontal line.

Gerald Goldberg, Director  
Technology Center 2700-  
Communications and Information Processing



FEB 25 1998

Director's Office  
Group 2700

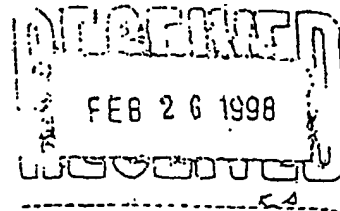


PATENTS AND TRADEMARK  
Washington, D.C. 20531



Paper No. 21

Robert E. Bushnell  
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Washington, D.C. 20005



In re Application of  
Gwon-Il Kim  
Application Serial No.  
08/447,279

Filed: May 22, 1995

For: SERVO CONTROLLER  
APPARATUS AND METHOD  
OF DISK RECORDING  
SYSTEM

) DECISION ON RENEWED  
) PETITION UNDER  
) 37 C.F.R. § 1.181

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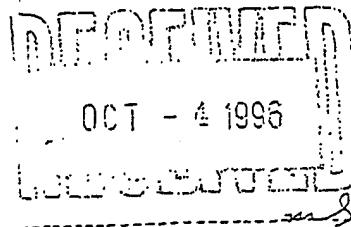
MAY 05 2004

TECHNOLOGY CENTER R3700

This is a decision on the renewed petition filed August 25, 1997 under 37 C.F.R. § 1.181 of the repeated requirement of the Examiner to label Applicant's Figures one through three as "prior art". The petition is treated as a request for reconsideration of the previous decision of August 19, 1997 in which the requirement of labeling figures one through three as "prior art" was maintained.

A careful review of the application papers indicates that the subject matter of figures one through three is considered by applicant to be "conventional". However, there is no indication in the disclosure that the subject matter of the figures is expressly considered by the applicant to be "prior art". "When applicant states that something is prior art, it is taken as being available as prior art against the claims. Admitted prior art can be used in obviousness rejections. In re Nomiya, 184 USPQ 607, 610 (CCPA 1975) (Figures in the application labeled "prior art" held to be an admission that what was pictured was prior art relative to applicant's invention.)" See M.P.E.P. § 2129. The decision, supra, was cited by both petitioner and the deciding official in the previous petition. Whether the subject matter of figures one through three of the instant application is prior art against the claims is an appealable determination and, accordingly, will not be entertained in this decision, see M.P.E.P. § 1201.

There is no requirement that a particular figure or figures be labeled as "prior art". The MPEP at section 608.02(g) indicates that if prior art figures are to be retained in the file they



#15

In re Application of  
MYUNG-CHAN JEONG  
Serial No: 08/343,939  
Filed on : November 17, 1994  
For : DIGITAL SERVO CONTROL  
APPARATUS AND METHOD  
OF DATA STORAGE SYSTEM  
USING DISK RECORDING  
MEDIA

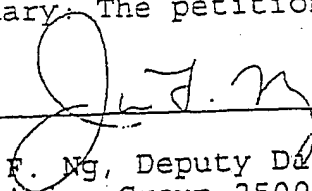
DECISION ON PETITION  
UNDER 37 CFR 1.181

This is a decision on the petition filed on September 13, 1996  
requesting the withdrawal of the requirement to label Fig. 3 as  
"Prior Art".

The petition is GRANTED.

A review of the record indicates that figure 3 as originally  
filed and discussed was referred to as "CONVENTIONAL". Hence, in  
keeping with the disclosure and petitioner's arguments, the  
examiners' requirement to label this figure as "Prior Art" is  
incorrect and withdrawn.

Summary: The petition is Granted.

  
Jin F. Ng, Deputy Director  
Examining Group 2500  
Electrical and Optical Systems  
and Devices

JFN/AMP

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OFFICE OF THE DIRECTOR  
GROUP 2500

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